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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, TUAN A

ART UNIT PAPER NUMBER

2618

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/612,346	MAUNEY ET AL.	
	Examiner	Art Unit	
	Tuan A. Tran	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20 and 28, drawn to a method and apparatus for establishing long range and short-range wireless communications wherein the apparatus comprises wireless communication circuitries configured both long range and short-range communications, classified in class 455, subclass 552.1.
 - II. Claims 21-23, drawn to a method for establishing wireless communication of a wireless communication device, classified in class 455, subclass 434.
 - III. Claims 24-27, drawn to a method for sharing database between wireless devices, classified in class 707, subclass 102.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions [I] and [II] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [I] has separate utility such as the apparatus comprises wireless communication

circuitries configured both long range and short-range communications. See MPEP § 806.05(d).

4. Inventions [I] and [III] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention [III] has separate utility means for sharing database between devices. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even through the requirement be traversed.
8. During a telephone conversation with Attorney Chad Herring (Reg. 41,067) on 03/29/2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20 and 28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-27 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this instant case, the limitation "physical contact" between the wireless communication device with the proximally located peer wireless device has not been described in the Specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8, 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haartsen (6,590,928).

Regarding claim 28, Haartsen discloses a wireless communication device (See fig. 12) comprising: an antenna; a transmitter coupled to the antenna; and wireless communication circuitry coupled to the transmitter, the wireless communication circuitry configured to communicate with a proximally located peer wireless device using low power short-range signal (second signal) (See col. 11 lines 26-31), wherein the communication with the proximally located peer wireless device is selected from a group consisting of wireless data (See figs. 6a, 6b, 7 and col. 12 line 50 to col. 13 line 8), a list of wireless device access numbers (See figs. 8-9 and col. 14 line 66 to col. 15 line 37), direct voice communication (See figs. 6a, 6b, 7 and col. 13 lines 9-16, lines 40-48), and a short-range messaging communication (See figs. 6a, 6b, 7 and col. 13 line 49 to col. 14 line 5). However, Haartsen does not mention the wireless communication device comprises a wireless communication circuitry configured to communication via a wide area wireless network using long range signal (first signal) (the long range signal is

Art Unit: 2682

commonly known to be greater than the short-range signal in strength). Since wireless communication device comprising both long range and short-range transceivers is well known in the art (Official Notice taken by the Examiner) as shown by U.S. patent No. 6,134,437 issued to Karabinis as evidence (See figs. 1-2); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the wireless communication device as disclosed by Haartsen with long range transceiver for the advantage of expanding the capability of the device to various types of communication protocols.

Claims 1-8 are rejected for the same reasons as set forth in claim 28.

Regarding claim 13, Haartsen discloses as cited in claim 6. Haartsen further discloses a memory for storing a list of wireless device addresses (See col. 14 lines 1-5).

2. Claims 9-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haartsen (6,590,928) in view of Hall et al. (6,032,051).

Regarding claims 14-15, Haartsen discloses an apparatus and method for establishing communication, the method comprising: communicating with a proximally located peer wireless device using short-range signal; and receiving a list of wireless device addresses from the proximally located peer wireless device (See col.11 lines 24-31, col. 14 line 66 to col. 15 line 45). However, Haartsen does not mention the steps of communicating with a wireless network using long range signal (the long range signal is commonly known to be greater than the short-range signal in strength) and transmitting

Art Unit: 2682

a find message including at least one wireless device address included in the list of wireless device addresses by using the long range signal. Hall teaches an apparatus and method for checking device status (See fig. 3), the method comprising the step of transmitting a find message (check status message) including at least one wireless device address included in a list of wireless device addresses by using the long range signal (the find message is transmitted to the HLR of the wireless network) (See fig. 12 and col. 5 lines 4-8). Since wireless communication device comprising both long range and short-range transceivers is well known in the art (Official Notice taken by the Examiner) as shown by U.S. patent No. 6,134,437 issued to Karabinis as evidence (See figs. 1-2); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the apparatus as disclosed by Haartsen with long range transceiver for the advantage of expanding the capability of the device to various types of communication protocols. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the step of transmitting the find message as taught by Hall for the advantage of permitting a user to monitor the status of device of any other user without manually establishing communication with the other user as suggested by Hall (See col. 2 lines 6-10).

Claim 9 is rejected for the same reasons as set forth in claims 14-15, as apparatus.

Regarding claim 16, Haartsen & Hall disclose as cited in claim 14. Haartsen further discloses the step of appending the list of wireless device addresses to a previously stored list of wireless device addresses (See col. 14 lines 1-5).

Regarding claim 17, Haartsen & Hall disclose as cited in claim 14. Hall further discloses the step of receiving a response message associated with a wireless device associated with the at least one wireless device address included in the first message (See fig. 12).

Claim 10 is rejected for the same reasons as set forth in claim 17, as apparatus.

Regarding claim 18, Haartsen & Hall disclose as cited in claim 14. Hall further discloses the step of transmitting a page message including the at least one wireless device address (See fig. 15 and col. 5 lines 24-49).

Claim 11 is rejected for the same reasons as set forth in claim 18, as apparatus.

Regarding claims 19-20, Haartsen & Hall disclose as cited in claim 14. Haartsen further discloses the steps of establishing a voice transmission with a wireless device associated with the at least one wireless device address and transmitting a text message to a wireless device associated with the at least one wireless device address (See col. 12 line 50 to col. 13 line 16, col. 13 lines 46-48).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schroderus et al. (6,477,384) ; Lehmusto et al. (5,771,463) ; Grube et al. (5,666,661); Aitkenhead (GB 2316271).

Conclusion


Art Unit: 2682

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Tran whose telephone number is (571) 272-7858. The examiner can normally be reached on Mon-Fri, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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SPE - 2618

Application/Control Number: 10/612,346
Art Unit: 2682

Page 10